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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,697	01/24/2006	Koichi Yamaguchi	36856.1406	2993

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EXAMINER

MAI, THIEN T

ART UNIT	PAPER NUMBER
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2887

NOTIFICATION DATE	DELIVERY MODE
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09/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/565,697	Applicant(s) YAMAGUCHI, KOICHI	
	Examiner Thien T. Mai	Art Unit 2887	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/03/2009 has been entered.

Objection

Claim 7: limitation "magnetically coupled through a space defined by the magnetic sheet" lacks clarity. Does "space" imply the magnetic coupling is to go through the sheet as the space or nearby empty space the sheet as indicated by item 11 in Fig. 2 of the present application? For examination purposes, it is interpreted as nearby space. Clarifications are respectfully requested.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 7-8 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kuwamoto et al.* (US 6216954 B1) in view of *Endo et al.* (US 6018298)

Kuwamoto et al. discloses
an antenna substrate 210 provided with a loop antenna (Fig. 3); and
a control substrate 18 having provided with a coil 17 and with a
transmitting/receiving circuit (fig. 4);

wherein

a magnetic coupling between the coil and the loop antenna causes the loop antenna and the transmitting/receiving circuit to be electrically connected to each other (Fig. 4, col. 5 lines 15-60).

Kuwamoto et al. is silent with respect to:

wherein a magnetic sheet is arranged on a surface of the antenna substrate facing the control substrate, and the coil and the loop antenna are magnetically coupled through a space defined by the magnetic sheet.

Endo et al. discloses a magnetic sheet in a tag 12 is arranged on a surface of the antenna substrate of an article that includes a card (col. 6 lines 27-32). *Endo et al.* further discloses that "FIGS. 1 and 2 illustrate a tag 12 attached to a theft-monitored article 11, in which the tag 12 includes a resonance circuit 14 for resonating radio waves of a specific frequency transmitted from an interrogator antenna 13 shown in FIG. 3. Further, the tag 12 includes a soft magnetic layer 16 which is disposed between the attaching surface of the article 11 and the resonance circuit 14. The article 11 in this

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embodiment is, for example, a ferromagnetic container 11a, made of a steel sheet which contains drinking water, candy or the like. The resonance circuit 14 includes a baseboard 17 formed of an insulation material such as paper or thin plastic (not shown), a spirally rectangular conductive coil 18 is made of, for example, copper or aluminum and formed on a side of the baseboard 17, and a capacitor 19 which is bonded to the same side of the base board 17 and is electrically connected to the coil 18. The capacitor 19 includes a pair of electrode layers 19a which are bonded to each other through a dielectric layer (not shown). The coil 18 is provided by coiling and bonding an insulation wire to the baseboard 17 so as to form a rectangular spiral, or by etching or stamping a conductive material, such as aluminum or copper foil, so as to remove unnecessary sections and to form a rectangular spiral. The soft magnetic layer 16 may be formed by any soft magnetic material such as an amorphous alloy, PERMALLOY, electromagnetic soft iron, silicon steel sheet, sendust alloy, Fe--Al alloy, and a soft magnetic ferrite. The soft magnetic layer 16 is a plane having substantially the same area as that of the baseboard 17, and is bonded with a bonding agent 21 to a surface of the baseboard 17 having the coil 18 and the capacitor 19. The soft magnetic layer 16 bonded to the baseboard 17 is fixed on the surface of the article 11 (i.e., the steel container 11a) with a bonding agent 22.” (col. 5 lines 9-44)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of *Endo et al.*

One of ordinary skill in the art would be motivated to employ the teachings of *Endo et al.* since they would allow an article sold at a point of sale terminal to be monitored for anti-theft purposes.

Re claim 8, *Kuwamoto et al.* in Fig. 1 shows entire control substrate 17 and antenna substrate being near equal in size. Fig. 3 shows antenna 201a taking nearly entire area of the card substrate. Fig. 4A shows control antenna being made of two coils. Fig. 4B shows control antenna comprising four small coils 17b. Therefore, it would have been obvious that a control antenna is smaller and positioned inside the loop antenna of card antenna 210a. It is further noted that changing size or shape of parts is not sufficient to patentably distinguished over the prior art. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Remarks

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant's request to examine previously non-elected claims is respectfully denied since these claims amount to distinct or independent species. Applicant is also reminded that the general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. See MPEP § 819.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thien T Mai/
Examiner, Art Unit 2887

/Thien M. Le/
Primary Examiner, Art Unit 2887